



JEFFREY D. SHEWCHUK
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

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OFFICE OF PETITIONS

In re Application of
Capitant et al.
Application No. 09/332,489
Filed: June 14, 1999
Attorney Docket No. S828.312-0002

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: DECISION DISMISSING
: PETITION
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This is a decision on the petition filed on January 21, 2000¹ under 37 CFR 1.47(a), requesting that 5 joint-inventors be allowed to file the application on behalf of themselves and the remaining joint-inventors who allegedly refuse to join in this application; and alternatively under 37 CFR 1.47(b),² requesting that Société Française du Radiotéléphone be allowed to make the application on behalf of and as agent for the allegedly non-signing joint-inventors.

The petition under 37 CFR 1.47(a) is **DISMISSED**.
The alternative petition under 37 CFR 1.47(b) is **DISMISSED as being inappropriate**.

Background

There are 8 joint-inventors for the claimed invention in this application: Arnaud Capitant ("Capitant"), Christophe François ("François"), Sophie Frey ("Frey"), Abdallah Hitti ("Hitti"), Olivier Jean-Marie ("Jean-Marie"), Philippe Lucas ("Lucas"), Philippe Mercier ("Mercier"), and Jean-Pierre Wary ("Wary"). The application as filed on June 14, 1999 did not include any oath or declaration as required by 37 CFR 1.51(b)(2) and as specified in 37 CFR 1.63. A Notice of Missing Parts was mailed on July 16, 1999 ("7/16/99 Notice") stating, *inter alia*, that the oath or declaration was missing. Applicants were given an extendable, non-statutory, 2-month period within which to submit the oath or declaration and other missing items.³ The instant petition was filed in response to the 7/16/00 Notice and encloses a request for a 4-month extension of time for filing these items.⁴

¹ Certificate of Mailing date 1/18/00. The application had been forwarded to the technology center in early 2000 for examination, and this petition was inadvertently not entered in the PTO system until recently. The Office sincerely apologizes for any inconvenience caused by the delay.

² Petition, page 1, last 3 lines.

³ MPEP 710.02(d) (Aug. 2001) (The 2-month period for reply to a Notice of Missing Parts is not identified in the Notice as a statutory period subject to 35 U.S.C. 133. Thus, a maximum of 5 months may be obtained under 37 CFR 1.136(a), extending the due date for the missing items to 2/16/00.).

⁴ A 4-month extension of time would only extend the due date for filing the missing items to 1/17/00 (Monday), one day before the 1/18/00 Certificate of Mailing date indicated on the petition. Thus, a 5th month is needed for timely filing the petition and the accompanying documents.

Petition under 37 CFR 1.47(a)

The instant petition, which includes a declaration signed by François, Hitti, Lucas, Mercier and Wary, requests that these joint-inventors be allowed to file this application on behalf of themselves and the remaining joint-inventors who allegedly refuse to join in this application, i.e., Capitant, Frey and Jean-Marie.⁵

François, Hitti, Lucas, Mercier and Wary may file this application on behalf of themselves as well as Capitant, Frey and Jean-Marie, provided that a *bona fide* attempt has been made to present to Capitant, Frey and Jean-Marie for signature a copy of the **entire** application, including the specification, claims, drawings, and declaration; and that Capitant, Frey and Jean-Marie refuse to join in this application.⁶ The oath or declaration in such an application must be accompanied by a petition under 37 CFR 1.47(a) which includes, *inter alia*, the **last known address** of each of Capitant/Frey/Jean-Marie,⁷ and a **statement of facts, by those who presented the application papers/concluded that Capitant, Frey and Jean-Marie refused to join in/to whom the refusals to join in were made, concerning the circumstances of the presentation of the application and the subsequent refusal.**⁸

The instant petition contains 3 declarations by a Frederic Forster ("Forster"), describing how certain documents had been presented to Capitant, Frey, and Jean-Marie for signature and were never returned. Each of the Forster declarations in essence states the last known address of Capitant/Frey/Jean-Marie, and that:

-Forster mailed Capitant/Frey/Jean-Marie a declaration and an assignment for signature on September 7, 1999;⁹

⁵ Petition, page 1, lines 1-2.

⁶ See also MPEP section 409.03(d) (Aug. 2001), REFUSAL TO JOIN (A refusal by an inventor to sign an oath/declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join in the application unless it is clear that the inventor understands exactly what he is being asked to sign and refuses to accept the application papers.); also citing *In re Gray*, 115 U.S.P.Q. 80 (Comm'r Pat. 1956) (It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath/declaration is directed.).

⁷ 37 CFR 1.47(a); also see MPEP section 409.03(e) (Aug. 2001) (An application filed under 37 CFR 1.47 must state the last known address of the non-signing inventor . . . at which the inventor customarily receives mail, . . . [o]rdinarily . . . the last known residence).

⁸ See MPEP section 409.03(d) (Aug. 2001) (When the 37 CFR 1.47 applicant concludes that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made).

⁹ 9/7/99 letter by Forster, referencing "4779US/PG-CC/R928.106."

- Forster mailed Capitant/Frey/Jean-Marie a letter on December 6, 1999, requesting that the previously mailed declaration and assignment be signed and returned,¹⁰
- Capitant/Frey/Jean-Marie has refused to sign,¹¹ and has never returned the declaration and assignment.¹²

However, there is no evidence, based on the Forster declarations, that a copy of the **entire application, including the specification, claims, drawings**, was presented to Capitant/Frey/Jean-Marie along with the September 7, 1999 letter. Consequently, the Office is unable to determine whether the Forster declarations constitute the "statements of facts" required for granting the petition under 37 CFR 1.47(a).¹³ The petition under 37 CFR 1.47(a) is thus dismissed.

Alternative petition under 37 CFR 1.47(b)

Also submitted with the instant petition is a Submission Under 37 CFR 3.73(b) ("3.73(b) Submission") by Société Française du Radiotéléphone ("Société"), allegedly the assignee of rights to this application,¹⁴ signed by Forster, Head of Legal Affair for Société and apparently authorized to act on behalf of Société.¹⁵ With this 3.73(b) Submission, the petition requests that Société be allowed, under 37 CFR 1.47(b), to make the application on behalf of and as agent for Capitant/Frey/Jean-Marie.

Unfortunately, a petition under 37 CFR 1.47(b) is permitted only if **all** of the inventors named in an application refuse to execute the application, or, cannot be found or reached after diligent effort, none of which applies to the scenario in this application, in that, 5 out of 8 joint-inventors have signed the declaration in the application. The alternative petition under 37 CFR 1.47(b) is thus dismissed as being inappropriate. No petition fee under 37 CFR 1.47(b) is owed.

¹⁰ 12/6/99 letter by Forster, referencing "4779US . . ."

¹¹ Forster Declaration, page 1, lines 4-5.

¹² Forster Declaration, page 2, lines 2-3, 5-6.

¹³ See supra note 6.

¹⁴ The Office notes that all parties having any portion of the ownership in the patent property must act **together** as a composite entity in patent matters before the PTO; see MPEP section 301 (Aug. 2001). The "assignment" executed by François, Hitti, Lucas, Mercier and Wary in 1999 was recorded in the PTO on 8/17/00, at Reel 011059, Frames 0158-0174. However, Applicants are reminded that, the recording of this "assignment" is not a determination by the PTO of its validity or its effect on the title to this application or the patent ultimately issued therefrom. When necessary, the PTO will determine what effect this "assignment" has, including whether a party has the authority to take an action in a matter pending before the PTO. See MPEP section 317.03 (Aug. 2001).

¹⁵ See 3.73(b) Submission, page 2.

Conclusion

To prevent abandonment of this application,¹⁶ a request for reconsideration of this decision (renewed petition under 37 CFR 1.47(a)) must be submitted within **TWO (2) MONTHS** from the mailing date of this decision, unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained. To be grantable, the renewed petition must include appropriate **statement(s) of facts**, stating that the **entire** application papers, including the specification, claims, drawings, and oath or declaration, were presented to each of Capitant/Frey/Jean-Marie at his/her **last known address**; and of the **facts** relied upon to conclude that Capitant/Frey/Jean-Marie each has refused to join in this application. The statement(s) of facts must be signed by **those who presented the application/made the stated contacts/concluded that each of Capitant/Frey/Jean-Marie has refused to join in/to whom the refusal to join in was made.**

Finally, the Office acknowledges receipt with the instant petition of a Power of Attorney and a certified priority document for claiming priority based on 2 French applications filed in 1998. The Power of Attorney has been entered and made of record.

Also received with the petition are: a \$1,660 check for paying the \$130 surcharge for late filing of the declaration, the \$130 petition fee, and the \$1,360 for a 4-month extension of time,¹⁷ totaling \$1,620;¹⁸ and a \$726 check for paying the \$690 basic filing fee and the \$36 extra claims fee, totaling \$726.¹⁹ In addition, the \$130 surcharge for late filing of the basic filing fee has been charged to Deposit Account No. 11-0982 as authorized in the "Response to Notice to File Missing Parts of Application - Filing Date Granted Under 37 CFR 1.53(f) and 1.16(e)" submitted with the instant petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

¹⁶ See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by §1.16(e) to avoid abandonment.).

¹⁷ See *supra* note 4 (The fee for a 5-month extension of time in 1/00 was \$1,850. The deficiency of \$490 has been charged to Deposit Account No. 11-0982 as authorized in the "Response to Notice to File Missing Parts of Application - Filing Date Granted Under 37 CFR 1.53(f) and 1.16(e)" submitted with the petition.).

¹⁸ The overpayment of \$40 has been credited to the same deposit account as authorized in the instant petition.

¹⁹ The basic filing fee currently in effect is \$760, and was \$690 in 1/00 when the instant petition was filed. The difference of \$70 had been erroneously charged to Deposit Account No. 11-0982 and has been reversed.

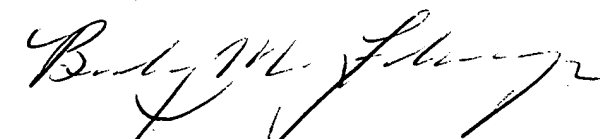
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By fax: (703)308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy